

### **REMARKS**

With careful attention to the Examiner's comments set forth in the Office Action dated September 12, 2005, the Application has been amended to place it in condition for allowance. In the Office Action, Claims 1-7 are rejected under 35 U.S.C. §102(b) as being anticipated by US Patent No. 4,946,032 (hereinafter "the Stoddard et al reference") and Claims 8 and 10-12 are rejected under 35 U.S.C. §102(b) as being anticipated by US Patent No. 5,448,844 (hereinafter "the Miller et al reference"). Claim 9 is rejected under 35 U.S.C. §103 over the Miller et al reference in view of the Stoddard et al reference.

Claims 1-2, 4-5, and 7-10 are currently pending and Claims 3, 6, 11, and 12 have been cancelled.

### **Brief Summary of the Present Invention**

The present invention relates to a method and apparatus for transforming the shape, contour and appearance of at least one side of a conventional product merchandising display unit such as a display cooler for merchandising soft drink products into a wide variety of different appearances (including changing the shape and/or contour) so as to attract consumer attention and promote sales. To achieve the goal, the present invention comprises steps of forming a panel member representative of the new shape and/or contour, the panel member having top and bottom flange portions, the top and bottom flange portions being respectively engageable with a product display unit; and attaching said panel member to at least one side portion of the product display unit thereby changing the appearance and shape and/or contour of the product display unit to the new appearance, shape and/or contour.

**Claim Rejection - 35 U.S.C. §102(b)**

**Legal Principles**

A claim is anticipated under 35 U.S.C. 102 only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Company, 814 F.2d 628 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim of the invention. Richardson v. Suzuki Motor Company, 868 F.2d 1226, 1236 (Fed. Cir. 1989). With regard to “inherency,” the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency or characteristic. In re Rijckaert, 9 F.3d, 1531, 1534 (F.2d 1993). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be recognized by persons of ordinary skill. Inherency, however, may be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In re Robertson, 169 F.3d, 743, 745. Also, a reference cannot anticipate a claim if there is any structural difference, even if the prior art device performs the function of the claim. In re Ruskin, 347 F.2d 843.

**Claims 1 and 5**

The Examiner asserts that all the limitations of Claims 1 and 5 of the present invention are disclosed by the Stoddard et al reference since recitation of “panel member” is taught by the

arcuate shape of panel member 11 in Fig. 1 of Stoddard et al and recitation of “attaching said panel to at least one side portion of the product display unit is also taught by the same prior art. Also, with regards to Claims 3 and 6, the Examiner asserts that Stoddard et al teaches the panel member having a bottom flange portion being engageable with the existing product display unit.

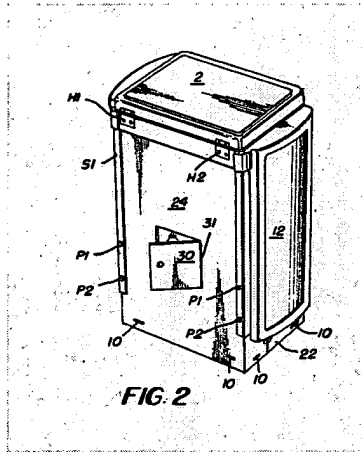
Applicant has respectfully amended Claim 1 by adding recitations that the present method transforms the shape of an existing display unit and recitations that the panel member includes a bottom flange portion engageable with channel means associated with the bottom portion of the product display unit.

Applicant has also amended Claim 5 by adding similar recitations including that the panel member includes top and bottom flange portions and that top and bottom flange portions are respectively engageable with the upper and bottom portions of product display unit.

**Contrary to the Examiner’s findings, the recitations of the present invention are not disclosed by Stoddard et al since Stoddard et al in no way teaches a step of attaching the panel to one side portion of the product display unit and attaching a panel member having a bottom flange portion wherein the bottom flange portion is engageable with channel means associated with the bottom portion of the existing product display unit.**

As disclosed in the specification and also recited in Claim 1 of the Stoddard et al, decorative covering means includes a plurality of panels arranged in an overlying or overlapping relationship and, contrary to the Examiner’s indication, Stoddard et al does not teach a step of attaching a single panel to a single side portion of the product display unit because the panels in Stoddard et al are secured to each other so that at least two panels are required. Referring to Fig. 4 and column 2, lines 25-30 of Stoddard et al, “[f]astening strips 16 and 17 are secured

together in flat face contacting relation by suitable means such as rivets inserted into apertures 19 and 20 in strip 17 and into corresponding apertures 19a and 20a in strip 16.” Therefore, Stoddard et al does not teach how to attach a single panel to a single side portion of the product display unit.



Further, as seen above and in Fig. 1, Stoddard et al does not disclose a bottom flange portion on the panel member which is engaged with channel means associated with the bottom of the product display unit. The bottom flange portion 50 of the present panel member is engageable with channel means 46 associated with the floor member 18 and this serves as a means for securing the panel to the product display unit whereas, in reality, there is no flange associated with the bottom portion of the Stoddard panel that is similar to flange 50 of the present panel member. If there is any flange associated with the bottom portion of the Stoddard panel, it certainly is not in the same plane as the panel, and it certainly is not engageable with channel means located at the bottom of the Stoddard unit. In fact, the bottom of the Stoddard panel does not even extend to the bottom of the Stoddard unit. See Figs. 1, 2 and 7 of Stoddard. Still further, the bottom flange portion in Stoddard is not a securing means. In Stoddard, the plurality of panels are secured to each other and the back panel is secured to the cooler by

fastening the strip of the panel (See Fig. 2 above, P1 and P2). Referring to Fig. 2 and column 2, lines 31-33 of Stoddard, “[t]he back panel S1 of panel 13 is secured to the enclosing structure by pins P1 and P2 which fasten strip S1 in place as shown in Fig. 2.” In no way under any definition will the alleged bottom flange taught by Stoddard meet the definition of a bottom flange portion of the present panel which is engageable with the bottom portion of the product display unit of the present invention.

Therefore, Stoddard cannot anticipate Claims 1 or 5 of the present invention because of the structural differences, even if the device of Stoddard performs similar functions as compared to Claims 1 or 5 of the present invention. See In re Ruskin, 347 F.2d 843. Furthermore, the functions of the present invention are not disclosed by the Stoddard et al reference. For example, the bottom flange portion of the present panel is engageable with the product display unit and this enables the present panel to be quickly and easily installed and removed without the use of tools. The securing means in the Stoddard et al reference, such as strips fastened by rivets, cannot achieve these functions. Therefore, claims 1 and 5 are now in condition for allowance.

#### Claims 2, 4 and 7

The Examiner rejected Claims 2 and 4 which depend from Claim 1 and also rejected Claim 7 which depends from Claim 5 as being anticipated by the Stoddard et al reference. The above remarks are equally applicable for these dependent claims. Also, there is no top flange portion associated with the Stoddard panel similar to flange 48 of the present panel which extends in the same plane of said panel and which is engageable as taught by the present

invention. Thus, the Stoddard et al reference does not anticipate all limitations of dependent Claims 2, 4 and 7. Therefore, these claims are now in condition for allowance.

Claims 8 and 10

The Examiner has rejected Claim 8 as being anticipated by the Miller et al reference. Applicant has amended Claim 8 to address this rejection. The Miller et al reference does not anticipate the limitation of attaching a panel member having a new contour associated therewith different from the specific contour of the body container to be transformed. Referring to Col. 1, lines 16-52 of the Miller et al reference, it discloses only a **planar panel** containing graphic images and advertising messages. The planar panel containing images cannot change the contour of the outer surface of the body container. Therefore, Claim 8 is now in condition for allowance.

The Examiner has also rejected Claim 10 which depends from Claim 8 as being anticipated by the Miller et al reference. The above remarks are equally applicable to dependent claim 10. Thus, the Miller et al reference does not anticipate all limitations of dependent Claim 10 since it likewise includes all of the limitations of Claim 8. Therefore, Claim 10 is likewise in allowable condition.

**Claim Rejection - 35 U.S.C. §103**

**Legal Principles**

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claim combination or combine the references and the reasonable expectation of success must both be found in the prior art and not based on the Applicant's disclosure. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

With regard to the first criteria for a suggestion or motivation to modify or combine references, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217 F.3d 1368 (Fed. Cir. 2000). However, the mere fact that the references can be combined or modified does not render the result and combination obvious unless the prior art also suggests the desirability of a combination. In re Mills, 916 F.2d 680 (Fed. Cir. 1990). The fact that the prior art references may be capable of being modified to function as the claimed apparatus is not enough, there must be a suggestion or motivation in the reference to do so. In re

Mills, 916 F.2d 682 (Fed. Cir. 1990). Further, a statement that modifications of the prior art to achieve the claimed invention would have been well within the ordinary skill of the art because the prior art relied upon teach that all aspects of the claimed invention were individually known is again not enough. The prior art is not sufficient to establish obviousness without some objective reason to combine the teachings of the references. In re Kotzab, 217 F.3d 1368 (Fed. Cir. 2000), also see In re Sang Su Lee, 277 F.3d 1338 (Fed. Cir. 2002). Also, the proposed modification would render the prior art being modified unsatisfactory for its intended purpose and there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900 (Fed. Cir. 1984).

The Examiner rejected Claim 9 under 35 U.S.C. 103(a) as being unpatentable over the Miller et al reference in view of the Stoddard et al reference. The Examiner indicated that the Stoddard et al reference teaches a panel member for a display unit having at least one side wing panel portion 17, said at least one side wing panel portion extending partially around portions of the product display unit when said panel member is attached thereto.

**However, as indicated above, the Miller et al reference does not teach a panel member having a contour associated therewith different from the specific contour of a portion of the body container to be transformed. Further, there would be no suggestion or motivation to make the proposed modification. Furthermore, the Miller et al reference teaches away from this combination with a method of transforming the contour of an outer surface of a product display unit as further explained below.**

There is no motivation or suggestion to combine or modify both references. Miller et al only teaches means for mounting a planar panel onto an outer surface of a support structure. It

does not teach or suggest a method of transforming the contour of an outer surface of a product display unit. Further, there is no motivation or suggestion to combine means for mounting a planar panel with a method of transforming the contour of an outer surface of a product display unit. To the contrary, Miller et al limits its planar panels to thin, flexible planar members. Referring to col. 1, lines 20-22 of the Miller et al reference, “[s]uch changeable panels are typically relatively thin, flexible planar members made from a plastic or paper material ....”

Further, to combine Miller et al with Stoddard et al, both the guide means of Miller et al and the securing means (strips fastened by rivets) of Stoddard et al should be eliminated. Referring to the Miller et al disclosure and to all of the independent claims of Miller et al, they recite “two opposed guide means positioned at predetermined locations on the outer surface of the support structure for cooperatively engaging at least portions of the opposed edge portions of the panel member.” Every embodiment disclosed by Miller et al requires the guide means to hold and support the planar panels. However, since both the guide means and the securing means are essential elements in both prior art references and since there is no teaching or suggestion in the references to combine these references, these references are not capable of being modified to function as the claimed method.

Furthermore, Miller et al teaches away from a combination with a method of transforming the contour of an outer surface of a product display unit. There is no motivation to combine if a reference teaches away from its combination with another source. Tec Air, Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353, 1360 (Fed. Cir. 1999). “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set forth in the reference, or would be led in a direction divergent from

the path that was taken by the applicant ... [or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the device." Id. (quoting In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994)). A prior art reference may teach away impliedly when a modification or combination would render inoperable the invention disclosed in the reference. In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984).

In McGinley v. Franklin Sports, Inc., McGinley's patent discloses and claims an instructional pitching device in the form of a regulation baseball with specific "finger placement indicia" for teaching students how to grasp a baseball for throwing different types of pitches. 262 F.3d 1339 (Fed. Cir. 2001). The indicia are coded by coloring all indicia which are representative of a certain type of pitch in one color and indicia representative of another type of pitch in a different color. Id. at 1344. To further assist a student in learning how to throw a particular pitch, the indicia are shaped so as to indicate the relationship of the palm of the hand in grasping the ball. Specifically, the portion of each "egg-shaped" indicium to be situated closest to the palm is slightly tapered so as to indicate the correct orientation of the baseball in the palm. Id. A patent to Pratt disclosed a baseball having multiple sets of finger placement indicia for teaching baseball players to throw different types of pitches. Specifically, Pratt's written description disclosed the placement of finger and thumb placement indicia for three types of pitches (*i.e.*, fast ball, curve ball, and screw ball). Id. at 1344-45. An equatorial band was an important feature of Pratt's claimed invention. When a student threw Pratt's baseball correctly, bands of complementary colors in the equatorial band would blend into a single color to provide a visual indication to the student that the ball had been thrown with proper rotation. Id. Pratt did not provide for different sets of indicia on a single ball for distinguishing between left-handed

and right-handed students. Id. A patent to Morgan disclosed a baseball training device using a lightweight and inexpensive baseball "replica" fabricated in the form of plastic or metallic hemispherical shells which occupy a minimum of space before use, but which can be easily assembled by gluing the two hemispherical halves together. A single set of finger-shaped marks was provided on the baseball training device to teach a student how to throw a baseball with a particular curve or break. Id. The Federal Circuit held that to combine the finger placements of Morgan with the Pratt ball would also render the Pratt ball inoperable, by eliminating the multi-colored equatorial band, a claimed feature of the Pratt patent also required for successful operation of Pratt's invention. Id. at 1354.

Likewise, in this case, the Miller et al references teaches away from its combination with the method of transforming the contour of an outer surface of a product display unit because opposed side edge portions of the panel having a different contour would not be able to be engaged with the guide members disclosed by Miller et al. The guide members disclosed by Miller et al would prevent transforming the contour of a product display unit and thus to combine the method of transforming the contour of Stoddard et al with the Miller et al mounting means would render the Miller mounting means inoperable. If you eliminate the guide members of Miller et al, then a claimed feature of the Miller et al invention, which is required for successful operation of Miller's invention, is eliminated and it would render the Miller et al invention inoperable. Claim 9 is therefore not made obvious by the Stoddard and Miller references, either alone or in combination.

It is now believed that all of the pending claims in the present invention, namely, claims 1, 2, 4, 5, and 7-10 contain limitations and restrictions which patentably distinguish them over

Application of: Paul L. Flum  
Serial No.: 10/604,802  
Amendment A

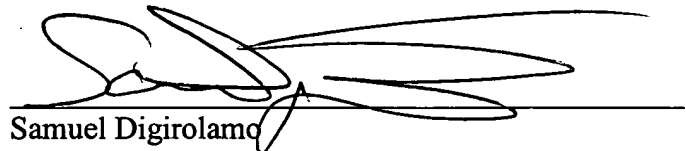
the cited prior art. None of the cited references, either alone or in any combination thereof, disclose or suggest all of the novel features associated with the present method for transforming the appearance and shape and/or contour of an existing product merchandising unit, nor do the prior art constructions provide the specific advantages and objectives obtained by the present method. Favorable action and allowance of the claims is therefore respectfully requested.

If any issue regarding the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's amendment, or if the Examiner should have any questions regarding the present amendment, it is respectfully requested that the Examiner please telephone Applicant's undersigned attorney in this regard.

Respectfully submitted,

Date: \_\_\_\_\_

26 Oct 05



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